

REMARKS

The above amendment with the following remarks is submitted to be fully responsive to the Office Action of October 10, 2003. Reconsideration of this application in light of the amendment and the allowance of this application are respectfully requested.

Claims 1, 2, 4-6 and 8-32 were pending in the present application prior to the above amendment. In response to the Office Action, claims 1, 6, and 29-32 have been amended. Therefore, claims 1, 2, 4-6 and 8-32 are still pending in the present application and are believed to be in proper condition for allowance.

Initially, the Applicants respectfully request the withdrawal of the finality of the present Office Action. In particular, as stated in the response of April 19, 2003 to the first Office Action, the cited Talib reference clearly did not relate to the claimed invention as originally filed. In the presently outstanding Office Action, the Examiner has introduced a new ground of rejection, and the finality of the rejection was not necessitated by the applicant's amendment of the claims in response to the first Office Action. The Examiner, by making this Office Action final, has essentially prematurely cut off the prosecution to merely one Office Action and substantive prosecution on the merits, which is improper. (See MPEP §§706.07-706.07(a)). Therefore, the withdrawal of the finality of the present Office Action is requested.

Referring now to the substantive Office Action, the Examiner initially rejected claims 1, 2, 4-6, and 8-32 under 35 U.S.C. 112, second paragraph, for the recitation of the terms "one or more devices" in the independent claims. In response thereto, independent claims 1, 29, and 31-32 have been amended to recite that the data records are stored in at least one computer readable storage medium. (See page 7, lines 6-14 of the Specification). Therefore, the Applicants contend that this rejection is overcome and the withdrawal of this rejection is respectfully requested.

Referring again to the Office Action, claims 1, 2, 4-6, and 8-32 were rejected under 35 U.S.C. 101. In this regard, the Examiner asserts that the claimed invention is directed to a non-statutory subject matter. The Examiner recites a two prong test for determining satisfaction of 35 U.S.C. 101, and further asserts that the claims as presently

drafted do not apply, involve, use, or advance the technology arts. The Applicants respectfully disagree.

In particular, with respect to claim 1 and the dependent claims depending therefrom, the method as claimed is directed to ranking of products based upon stored data records which are stored in at least one computer readable storage medium as now recited. The Background section of the application sets forth the practical application to which the invention is directed, i.e. comparison shopping facility and e-commerce. (See page 2 of the Specification). Thus, the present invention is not directed to mere ideas in the abstract as asserted by the Examiner in his rejection, but instead, is directed to a specific method of ranking physical products based upon data associated therewith by applying presently existing technological arts, and the present invention further advances the technological arts associated with e-commerce and comparison shopping. Therefore, the present invention is clearly limited to a practical application within the technical arts and satisfies the requirements of 35 U.S.C. 101. (See MPEP §2106.IV.B.2(b)).

In addition, it is noted that the recited claim further requires the step of receiving a selection from a user of at least one feature category that is of importance to the user of the product category. This step is clearly an independent physical act that is performed outside of any processor/computer used for implementing the present method. Furthermore, claim 1 specifically recites that the feature category received as a selection from the user is further processed by assigning an increased weight importance thereto, and recites the step of ranking products in the product category based on the increased weight importance. Thus, both of the recited steps further process the data associated with the independent physical act of receiving a selection from a user, such processing being deemed as statutory subject matter. (See MPEP §2106.IV.B.2(b) which states: “Another statutory process is one that requires the measurements of physical objects or activities to be transformed outside of the computer into computer data, where the data comprises signals corresponding to physical objects or activities external to the computer system, and where the process causes a physical transformation of the signals which are intangible representations of the physical objects or activities”; and “[A] claim is limited

to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful.”).

Furthermore, it is also noted that independent claim 1 has further been amended to recite that the data records are stored in at least one computer readable storage medium. In this regard, the applicants respectfully contend that such recitation provides a further basis for satisfying the statutory requirements. (See MPEP §2106.IV.B.1 which states: “When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.”). Therefore, in view of all of the above, the withdrawal of this rejection relative to claims 1, 2, 4-6, and 8-28 is respectfully requested.

In addition, with respect to the remaining claims 29-32 it is believed that the above arguments with respect to claim 1 also applies. In particular, claim 29 has been amended to specifically recite the steps of receiving a selection from a user of at least one feature category, and the step of providing to the user the ranking of products in the product category. In addition, independent claims 30, 31, and 32 now also recite limitations establishing the statutory subject as discussed above relative to claim 1. Therefore, reconsideration and the withdrawal of this rejection are respectfully requested with respect to these claims as well.

Finally, with respect to this statutory subject matter rejection, it is further noted that whereas the above remarks clearly overcome the Examiner’s rejection, if the Examiner still disagrees with the Applicants, it is requested that the Examiner identify the features of the invention that would render the claimed subject matter statutory if recited in the claim. (See MPEP §2106.IV.B which states: “If the invention as set forth in the written description is statutory, but the claims define subject matter that is not, the deficiency can be corrected by an appropriate amendment of the claims. In such a case, Office personnel should reject the claims drawn to nonstatutory subject matter under 35

U.S.C. 101, but identify the features of the invention that would render the claimed subject matter statutory if recited in the claim.”).

Referring again to the Office Action, claims 1, 2, 4-6, and 8-32 were also rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,875,110 or U.S. Patent No. 6,360,139, both to Jacobs. Jacobs is directed to a method and system for vending greeting cards based upon customer’s response to various selection criteria relating to the type of greeting card the customer would like to purchase. In particular, the reference discloses a method and system in which the customer’s selection criteria are used to determine which greeting cards are potentially suitable for a customer’s purposes, needs, interests and tastes. In addition, the reference further discloses that the method and system ranks the greeting cards based on their suitability to thereby facilitate the customer’s final selection of a card, and to allow the user to rank the importance of each category in determining suitability of greeting cards. The Examiner asserts that although Jacobs does not specifically state increased weighted importance of a feature category selected, it would have been reasonable and obvious to one of ordinary skill in the art to provide a weighted selection criteria for the method and system disclosed in Jacobs. The Applicants respectfully disagree with this rejection.

In particular, it is noted that whereas the method and system disclosed in Jacobs provide a suitability matrix that utilize categories/subcategories for greeting cards that allow the user to provide weightings for categories, the method and system itself, does not assign a weighted importance to the feature categories based on available data in the data records as claimed. In this regard, it would not make any sense to provide initial weightings to the method and system disclosed in Jacobs since purchase of a card is very personal and situation specific. A particular greeting card can be preferred by one user while not preferred by another user for any variety of personal/situational reasons. Consequently, initially weighting of categories of such cards would be meaningless, and in fact, go against the teachings of Jacobs which allows for the maximum number of appropriate cards to be generated based on inputs of the user. Thus, there is no logical basis for the system to weigh a category/subcategory of cards over another

category/subcategory and the user of the method and system disclosed in Jacobs would merely select the category and subcategory that is appropriate. Although the disclosed system allows user selection of importance of each category, weighting of such categories and subcategories by the method and system based on available data in the data records is not disclosed, taught or otherwise suggested in Jacobs. In view of the above, one of ordinary skill would not be motivated to provide such weightings in the application as disclosed by Jacobs and the Examiner fails to establish a prima facie case of obviousness by failing to point to any teachings in Jacobs or other prior art references to provide such weightings to the feature categories based on available data in the data records. Instead, the Examiner merely asserts in the Office Action that the novel features of the present invention would be obvious without providing any detailed support.

In the above regard, the Examiner is respectfully reminded that “to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teachings or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” (See MPEP §§ 2142 and 2143).

In addition, the Examiner fails to establish prima facie case of obviousness with respect to the various other dependent claims and independent claims of the present application. For example, the Examiner fails to establish why the steps as recited in claim 4 would be obvious, claim 4 specifically reciting the steps of assigning a tag to each essential feature category, assigning a relation type of kind to each product category, creating links within each product category to reflect the assigned relation, and using the assigned relation to create at least one hierarchical product category tree. With respect to claim 6, the Examiner fails to establish a prima facie case of obviousness as to why it would be obvious to assign a property type to each feature category and assign an

evaluative metrics to each feature in each feature category based on the feature category property type. The same remarks are deemed to apply with respect to claims 5, and 8-12.

Furthermore, with respect to claim 13 and 14, the Examiner fails to establish why it would be obvious to include the step of deriving ranges of values within feature categories from data records to determine natural ranges for grouping numerical features. It is respectfully noted that greeting cards typically do not include numerical features at all. Therefore there would be no motivation or teachings in Jacobs' references to implement the steps as claimed in claims 13 and 14. With respect to claim 15, it is noted that this claim specifically requires application of statistical analysis to derive the placement of an item within a product category with respect to at least one feature category. It is noted that Jacobs does not teach or otherwise suggest application of statistical analysis, and such analysis is not foreseen in view of the fact that greeting cards do not feature categories to which statistical analysis may be applied. The same arguments are deemed to apply with respect to claims 16-20.

Moreover, the Examiner also fails to establish why it would be obvious to one of ordinary skill in the art to modify the method and system of Jacobs so as to incorporate various products offered by plurality of merchants as recited in claim 21. It is respectfully noted that Jacobs merely discloses greeting cards that can be purchased through a method and system disclosed, such greeting cards being of a single brand which is provided by a single merchant. Various arguments submitted above are deemed to also be applicable to claims 22-28 that depend from claim 1 discussed above, as well as to independent claims 29-32. Thus, in view of the above remarks, the withdrawal of this rejection and the allowance of claims 1, 2, 4-6, and 8-32 are respectfully requested.

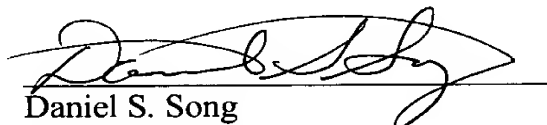
However, to more clearly define the present invention, independent claims 1 and 29-32 have been amended to specifically recite that the method/system of the present invention ranks products of a plurality of different brands. (See page 9, lines 3-14 and page 10, lines 15-19 of the Specification). Clearly, Jacobs fails to disclose such a feature as now recited in these claims. In addition, claim 1 has been amended to specifically recite the step of assigning evaluative metrics to each feature in each feature category,

ranking products of the plurality of different brands according to the weighted importance as well as on each product's evaluative metrics, and the step of providing to the user, a ranking of products ranked based on the increased weight importance and each product's evaluative metrics. Clearly, Jacobs also fail to disclose, teach, or otherwise suggest these steps and features of the present invention as now claimed. Corresponding amendments have further been added to incorporate such features in the other independent claims unless otherwise recited in unamended form. Claim 6 has been amended to better correspond to now amended claim 1. Therefore, reconsideration and withdrawal of this rejection with respect to all of the pending claims, namely claims 1, 2, 4-6 and 8-32, and the allowance thereof, are respectfully requested.

If the Examiner disagrees with the above remarks, the Examiner is invited to provide specific, detailed comments as to how the Jacobs reference, or any other reference of record, disclose, teach, or otherwise suggest the features of the present invention as now claimed.

In view of the foregoing amendments and remarks, Applicants respectfully request the Examiner's reconsideration of this application, and the timely allowance of the pending claims. Applicants respectfully request that the Examiner enter the present amendment because the amendment places the application in condition for allowance.

Respectfully submitted,


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